

Appln. No. 10/760,167  
Filed: January 16, 2004  
Reply to Office action mailed May 15, 2007  
Response filed November 15, 2007

## **REMARKS**

Claims 22-88 are pending in the Application and all are rejected in the Office action mailed May 15, 2007. No claims are amended by this response. Claims 22, 39, 58 and 73 are independent claims. Claims 23-38, 40-57, 59-72 and 74-88 depend from independent claims 22, 39, 58 and 73, respectively.

The Applicants respectfully request reconsideration of the pending claims 22-88, in light of the following remarks.

### **Rejections of Claims**

#### **Rejections Of Claims Under 35 U.S.C. §103**

Claims 22, 24, 25, 28-30, 33-39, 41, 42, 45-47, 50-58, 61, 63-66, 69-73, 76, and 82-86 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken (WO 91/08629) in view of Richter, et al. (US 6,104,706, hereinafter "Richter"). Claims 23, 40, and 81 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Cripps (US 5,838,730). Claims 26, 27, 31, 32, 43, 44, 48, 49, 59, 60, 62, and 75 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Perkins (US 5,159,592). Claim 67 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Callon et al. (US 5,251,205, hereinafter "Callon"). Claim 68 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Reece et al. (US 5,915,214, hereinafter "Reece"). Claims 77-79 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Lewen et al. (US 5,341,374, hereinafter "Lewen"). Claim 80 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter, Lewen, and McKee et al. (US 5,477,531, hereinafter "McKee"). Claims 87 and 88 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Focsaneanu et al. (US 5,610,910, hereinafter "Focsaneanu"). Applicants respectfully traverse the rejections.

The Applicant respectfully submits that the Examiner has failed to establish a case of *prima facie* obviousness for at least the reasons provided below. M.P.E.P. §2142 clearly states that "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." The M.P.E.P. §2142 goes on to state that "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

With regard to claims 22, 39, 58, and 73, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness, as required by M.P.E.P. §2142, and that claims 22, 39, 58, and 78 define allowable subject matter, for at least the reasons set forth during prior prosecution, and in addition, for those set forth below.

More specifically, Applicants respectfully submit that Richter (US 6,104,706) is not, in and of itself, valid prior art, and that the Office cites Richter based upon a claim of priority to the filing date of an abandoned application that is not available for inspection by the Applicants. Therefore, Applicants respectfully submit that Applicants have not been provided with "...such information and references as may be useful in judging of the propriety of continuing the prosecution of his application ...", as required under 35 U.S.C. §132.

Applicants respectfully submit that the instant application, which was filed January 16, 2004, is a continuation of U.S. Patent Application No. 10/141,506 (the "'506 application") filed May 8, 2002, which is a continuation of U.S. Patent Application No. 09/037,535 (the "'535" application") filed March 10, 1998, which is a continuation of U.S.

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Patent Application No. 08/539,817 (the "'817 application") filed October 5, 1995. Applicants respectfully submit that the claims of the Application are fully supported by the disclosure of the '817 application. Therefore, Applicants respectfully submit that the effective date of priority of the instant application is October 5, 1995.

In view of Applicants' effective priority date, Applicants respectfully submit that the Richter reference cited in the Office action, U.S. Patent No. 6,044,706, filed as U.S. Application No. 09/437,269 (the "'269 reference") on November 10, 1999, is not valid prior art. The '269 reference, however, is a continuation of and claims priority to U.S. Patent Application No. 08/626,580 (the "'580 reference"), filed April 2, 1996. Applicants respectfully submit that, in view of Applicants' effective date of priority, the '580 reference is also not valid prior art. The '580 reference, however, is a continuation application claiming priority to U.S. Patent Application No. 08/073,956 (the "'956 reference"), filed June 9, 1993. Therefore, it appears that the Office relies upon a claim to the filing date of the '956 reference, the only application in the chain of continuation applications filed by Richter that has a priority date predating Applicants' priority date of October 5, 1995, is the '956 reference. The '956 reference, however, was expressly abandoned on June 27, 1996. The Office, however, cited and provided access to the disclosure of the '269 reference, not the '956 reference.

Applicants respectfully submit that Applicants have not been provided with a copy of the '956 reference by the Office, and are unable to retrieve a copy of the '956 reference. Therefore, Applicants have not been given a fair opportunity to review the only possible valid prior art in the chain of priority of Richter, and that Richter has not been provided to the Applicants as required by 35 U.S.C. §132.

In addition, Applicants respectfully submit that the proposed combination of references fails to teach, suggest, or disclose, at least, "...wherein digital voice packets wirelessly exchanged by the at least one portable terminal comprise destination information used for routing the digital voice packets through the communication

network...", as recited by Applicants' claim 22; "...wherein the packets comprising digital representations of sound also comprise destination information used for routing the packets through the communication network....", as recited in Applicants' claim 39; and "...wherein digital voice packets wirelessly exchanged by the communication device and the at least one access device comprise destination information used for routing the digital voice packets through the communication network...", as recited by Applicants' claims 58 and 78.

The Office action asserts that Berken discloses "...wherein digital voice packets wirelessly exchanged by the at least one portable terminal comprise information used for routing (see FIG. 3, control time slot of frame; and/or FIG. 4, packet header of the voice time slot) the digital voice data packets through the communication network (see page 9, line 1-10; see page 10, line 17-30; control time slot of the transmit/receive frame comprises target/destination routing/forwarding information through PSTN, Ethernet LAN, or Token Ring LAN; and/or a packet header of the voice time slot comprises target/destination routing/information through PSTN, Ethernet LAN, or Token Ring LAN)." (Office action page 4, lines 10-17 and page 7, lines 3-10) Applicants note that this argument is virtually identical to that set forth in the prior Office action (see Office action of September 7, 2006, pages 14-15), with the exception that the limitation "destination" has been removed. Applicants appreciate recognition by the Office that Berken does not teach "destination", but continue to respectfully disagree with what is allegedly taught by Berken.

As Applicants stated in the previous response (see response of March 6, 2007), Berken teaches a wireless in-building telecommunication system for voice and data communication having at least one node and a multiplicity of user modules linked to the node via a shared RF communications path. (Abstract) Berken clearly teaches that time on the shared RF communications path is divided into frames comprising a number of time slots in a group for node transmit and a group used for node receive. Berken further teaches that each group is divided into three subgroups of control time slots,

voice time slots and data time slots. (FIG. 2; page 10, lines 16-22; FIG. 3; page 9, lines 2-5) Each of the time slots is divided into four parts: bus control, packet preamble, packet header, and packet information, and the voice, data or system control information is contained in the packet information portion. (page 9, lines 6-9; page 10, line 19-20) Berken teaches that the time slots within the frames are assigned for the use of the nodes and the multiplicity of user modules according to a bandwidth allocation scheme in which, when a module requires bandwidth, it will use a predetermined control time slot to request bandwidth from the node, and a time slot or group of time slots is then assigned to that module for its use. (Abstract; page 2, line 24 to page 3, line 18; page 9, lines 18-27; page 11, lines 3-6) Applicants respectfully submit that the individual time slots of any frame may be directed to any of a multiplicity of users.

The Office cites Fig. 3 of Berken, and more specifically, the "...control time slot of frame..." as teaching "...wherein digital voice packets wirelessly exchanged by the at least one portable terminal comprise information used for routing the digital voice data packets through the communication network...." Applicants respectfully disagree. Berken states that Fig. 3 "...shows the time slot arrangement within the frame." (page 3) Berken's Fig. 3 is shown below:

NODE TRANSMIT			FRAME	NODE RECEIVE		
CONTROL TIME SLOTS	VOICE TIME SLOTS	DATA TIME SLOTS		CONTROL TIME SLOTS	VOICE TIME SLOTS	DATA TIME SLOTS

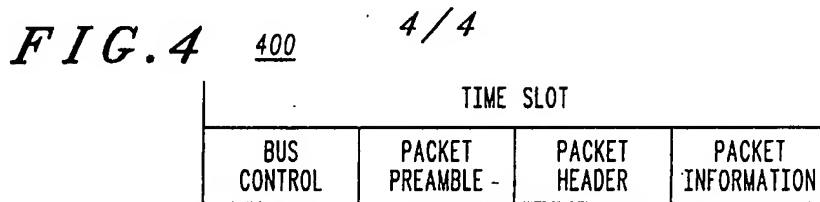
300

**FIG. 3**

Applicants respectfully submit that nothing in Fig. 3 (or the related text) of Berken, which was specifically cited as teaching "...wherein digital voice packets

wirelessly exchanged by the at least one portable terminal comprise information used for routing the digital voice data packets through the communication network...", teaches or suggests anything with respect to a digital voice packet comprising information used for routing the digital voice data packets through the communication network, in accordance with Applicants' claims 22, 39, 58, and 78. Applicants respectfully maintain that, as clearly shown in Fig. 3, the control time slots of Berken are separate from the voice time slots, and that a voice packet is contained within a voice time slot within a frame, and not within a control time slot. Any routing information alleged to be contained within packets in the control time slot is, therefore, not contained within a voice packet, in accordance with Applicants' claims 22, 39, 58, and 78. Therefore, this is different from and fails to teach or suggest at least this aspect of Applicants' claims 22, 39, 58 and 73.

The Office action also cites FIG. 4 of Berken, and more specifically, the packet header of the voice time slot, as teaching "...wherein digital voice packets wirelessly exchanged by the at least one portable terminal comprise information used for routing the digital voice data packets through the communication network...." Applicants again respectfully disagree. Berken states that Fig. 4 "...shows the contents within a time slot." (page 3) Berken's Fig. 4 is shown below:



Applicants respectfully submit that Fig. 4 of Berken simply shows a portion of the time slot labeled "PACKET PREAMBLE", and that nothing in Fig. 4 of Berken, which was specifically cited as teaching "...wherein digital voice packets wirelessly exchanged by the at least one portable terminal comprise information used for routing the digital

voice data packets through the communication network...", nor any other portion or figure of Berken, teaches or suggests anything with respect to the wireless exchange of digital voice packets comprising information used for routing the digital voice data packets through the communication network, in accordance with Applicants' claims 22, 39, 58, and 78.

Applicants respectfully submit that the following portion of Berken describes Fig. 4:

Each time slot has the same basic format shown in Fig. 4. A time slot is divided into four parts: bus control, packet preamble, packet header, and packet information. The voice, data or system control is contained in the packet information portion.

This system allows for maximum spectral efficiency by allocating the required bandwidth to each of the users of the common communication path. As mentioned above, previous systems did not allocate on a need bases [sic], but rather allocated the bandwidth at system startup. As a result, this system takes advantage of the fast packet switching technology that allows both circuit and non-circuit connections to be made in the same system.

The control time slots are used for system control and bandwidth allocation. When a user module or interface unit requires voice or data bandwidth, it will use a predetermined control time slot to request bandwidth from the node. The node will allocate the bandwidth, if available, and notify the user module and interface unit of the bandwidth allocation via a predetermined control time slot. The user module and interface unit will use the bandwidth until it is no longer required. At that point, the user module and/or the interface unit will use a predetermined control time slot to send a de-allocation request to the node. The node will use a predetermined control time to acknowledge the de-allocation of the bandwidth to the user module and interface unit.

Applicants respectfully submit that nothing in the text of Berken shown above, which describes the content of cited Fig. 4, nor any other figure or portion of Berken teaches or suggests anything with respect to "...wherein digital voice packets wirelessly

exchanged by the at least one portable terminal comprise information used for routing the digital voice data packets through the communication network...", in accordance with Applicants' claims 22, 39, 58, and 78. Berken offers no detail about the contents or use of the "packet preamble" shown in Fig. 4.

The Office action also cites Berken at page 9, lines 1-10, which state (underlined):

There will be a repetitive frame occurring periodically which contains system control, voice, and data packets necessary for the correct operation of the system. The frame shown in Fig. 2 is made up of a fixed number of time slots. Fig. 3 shows how the time slots are divided into two basic groups; node transmit and node receive. Each of these two groups is further divided into three subgroups; control time slots, voice time slots, and data time slots.

Each time slot has the same basic format shown in Fig. 4. A time slot is divided into four parts: bus control, packet preamble, packet header, and packet information. The voice, data or system control is contained in the packet information portion.

This system allows for maximum spectral efficiency by allocating the required bandwidth to each of the users of the common communications path. As mentioned above, previous systems did not allocate on a need bases [sic], but rather allocated the bandwidth at system startup. As a result, this system takes advantage of the fast packet switching technology that allows both circuit and non-circuit connections to be made in the same system.

The Office action also cites page 10, lines 17-30 of Berken, which states (underlined):

Time slot assignment bandwidth allocation is described as follows:

In a fast packet communication system, the communication channel is divided into frames. Each of these frames is a given length in time. Each frame is broken



into time slots. Each of these time slots contains a packet of information. This is shown in Fig. 2. All time slots are available for use by any node or module requesting bandwidth. This request can be for either voice or data transfer.

Using a time division multiple access (TDMA) scheme, the frame is divided into sections (groups of time slots), one transmit and one receive for the nodes. The nodes used their allocated portion of the frame to communicate with user modules and other nodes. As a node's requirement for bandwidth changes, its portion of the frame will increase or decrease as required. This change of the frame (time slot) allocation requires coordination between all of the nodes.

When a request is made for voice information transfer, a time slot is allocated for the duration of a call -- this is known as a "circuit switched path". When a request is made for data information transfer, a time slot is allocated for a single frame or group of frames -- this is known as a "packet switched path".

Applicants respectfully submit that nothing in the portion of Berken shown above, which was also specifically cited by the Office action, nor any other figure or portion of Berken, teaches or suggests anything with respect to "...wherein digital voice packets wirelessly exchanged by the at least one portable terminal comprise information used for routing the digital voice data packets through the communication network...", in accordance with Applicants' claims 22, 39, 58, and 78.

The Office action suggests that the "...control time slot of the transmit/receive frame comprises control information routing/forwarding information through PSTN, ... or Token Ring LAN)..." teaches Applicants' "...information used for routing the digital voice packets through the communication network." (page 4, lines 13-17; page 7, lines 6-10) Applicants respectfully disagree.

Applicants respectfully submit that there is no "...control time slot of the transmit/receive frame..." but, rather "control time slots". Applicants respectfully submit

that Berken clearly shows in Fig. 3 that the "node transmit" and "node receive" groups each have "control time slots", and that according to Berken, the "control time slot" is used to request allocation and de-allocation of bandwidth on the shared communication path. (page 9 at lines 18-27). As is well known in the art, a "packet" may be defined as "...[a] unit of information transmitted as a whole from one device to another on a network...." (See, e.g., Microsoft Press Computer Dictionary - Third Edition, 1997, Microsoft Corporation) Applicants respectfully submit that the "frame" of Berken is not analogous to a "packet", a term recited in Applicants claims 22, 39, 58, and 78. Instead, the frame of Berken is a certain period of time, which has been divided into a number of slots of time that are allocated for various uses. Berken clearly states that "...[t]he frame shown in Fig. 2 is made up of a fixed number of time slots. Fig. 3 shows how the time slots are divided into two basic groups; node transmit and node receive." (page 9, lines 1-3) Each of these groups is made up of control, voice, and data time slots. Berken teaches that different time slots of a group may be allocated for use by different "user modules" and "interface units." (page 10, line 17-30) Therefore, neither Berken's "transmit/receive frame" nor the "node transmit" and "node receive" groups are analogous to a "packet", as recited in Applicants' claims 22, 39, 58, and 78.

In addition, Applicants respectfully submit that the "control time slots" are not a part of a voice packet, but are used in Berken to exchange requests for allocation and de-allocation of the shared bandwidth of the communication path. Nothing in Berken, however, teaches that the "control time slots" comprise "...information used for routing the digital voice data packets through the communication network...", in accordance with Applicants' claims 22, 39, 58, and 78.

Applicants respectfully submit that the Office has failed to show where Richter remedies the above-identified shortcomings of Berken. Therefore, Applicants respectfully submit that the proposed combination of Berken and Richter fails to teach or suggest all of the limitations of Applicants claims 22, 39, 58, and 78.

Based at least upon the above, Applicants respectfully submit that the Office has failed to show where the proposed combination Berken and Richter teaches or suggests "...wherein digital voice packets wirelessly exchanged by the at least one portable terminal comprise information used for routing the digital voice data packets through the communication network...", in accordance with Applicants' claims 22, 39, 58, and 78, that the proposed combination or references fails to teach or suggest each and every limitation of Applicants' claims, as required by M.P.E.P. §2142, and that the Office has, therefore, failed to establish a *prima facie* case of obviousness.

The Applicants appreciate recognition by the Office that Berken "...does not explicitly disclose destination." (page 4, line 18; page 7, line 11) As set forth above, this is not all that Berken does not teach. However, in an attempt to overcome this shortcoming of Berken, the Office turns to Richter, stating that "...Richter teaches wherein digital voice packets comprise destination information used for routing...." (page 4, lines 20 to page 5, line 3; page 7, lines 13-18) The Office continues stating that "...therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide destination, as taught by Berken [sic] and well established teaching in art in the system of Berken, so that it would provide capability to the caller and callee to hear each other; see Richter col. 7, line 10-19, and it would also identify and locate the recipient of the voice data packet." (Office action at page 5, lines 3-7; page 18-22)

Applicants respectfully submit that the Office identified the alleged motivations for modifying the system of Berken using Richter as "...so that [Berken's "Wireless In-Building Telecommunications System] would provide capability to the caller and callee to hear each other..." and "...it would also identify and locate the recipient of the voice data packet...." Applicants respectfully submit that the alleged motivations for making the combination are not valid motivations, in that the system of Berken already functions to "...provide capability to the caller and callee to hear each other..." and "...and identify and locate the recipient of the voice data packet...." Applicants respectfully submit that

Berken discloses "...[a] wireless in-building telecommunication system for voice and data communications...." (Summary) Applicants assume that, based upon assertions by the Office that Berken teaches "...at least one portable terminal having a wireless transceiver adapted for communication using a packet protocol;...", "...the at least one portable terminal adapted for converting sound into digital voice packets for transmission via the wireless transceiver, and for receiving digital voice packets via the wireless transceiver, the contents of the digital voice packet for conversion into sound;...", "...the at least one portable terminal adapted for capturing digital data into data packets for transmission via the wireless transceiver, and for receiving data packets via the wireless transceiver, the contents of the data packets used for reproducing digital data;...", and "...at least one access device having a wireless transceiver for exchanging one or both of digital voice packets and digital data packets with the at least one portable terminal, the at least one access device comprising a network interface for exchanging information via a wired network...", that Berken functions to, at least, "...provide capability to the caller and callee to hear each other..." and "...and identify and locate the recipient of the voice data packet...." Applicants respectfully submit that if Berken did not function to "...provide capability to the caller and callee to hear each other..." and "...and identify and locate the recipient of the voice data packet...", then the system of Berken would also not teach the features of Applicants claims 22, 39, 58, and 78. Therefore, Applicants respectfully submit that the alleged motivations to "...provide capability to the caller and callee to hear each other..." and "...and identify and locate the recipient of the voice data packet..." are not valid or proper motivations for one of ordinary skill in the art to seek to modify Berken using the teachings of Richter. Based at least upon the above, Applicants respectfully submit that the Office has failed to identify "...some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings...", as required by M.P.E.P. §2142, and that the Office has failed to establish a *prima facie* case of obviousness.

In light of the above, Applicants respectfully submit that the Richter reference was chosen without a valid or proper motivation, and instead, was chosen because it allegedly discloses the one feature of Applicants' claims 22, 39, 58, and 78, namely "destination", admitted by the Office to be missing from Berken.

Applicants respectfully submit that M.P.E.P. 2141 (II)(B) states, in part, "references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination." This is also supported in case law, "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Weslau, 353 F.2d 238, 241 (United States Court of Customs and Patent Appeals, 1965) (emphasis added).

Therefore, Applicants respectfully submit that Applicants' claims 22, 39, 58, and 78 are allowable over the proposed combination of Berken and Richter, for at least the reasons set forth above. Applicants respectfully submit that claims 23-38, 40-57, 59-72 and 74-88 depend either directly or indirectly from independent claims 22, 39, 58 and 73, respectively. Because claims 23-38, 40-57, 59-72 and 74-88 depend from independent claims 22, 39, 58 and 73, Applicants respectfully submit that claims 23-38, 40-57, 59-72 and 74-88 are also allowable, for at least the same reasons. Therefore, Applicants respectfully request that the rejections of claims 22, 24, 25, 28-30, 33-39, 41, 42, 45-47, 50-58, 61, 63-66, 69-73, 76 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

With regard to rejections of claims 23, 26, 27, 31, 32, 40, 43, 44, 48, 49, 59, 60, 62, 67, 68, 75, 77-79, 80, 81, 87 and 88, Applicants respectfully submit that claims 23, 26, 27, 31, 32, 40, 43, 44, 48, 49, 59, 60, 62, 67, 68, 75, 77-79, 80, 81, 87 and 88 depend either directly or indirectly from claims 22, 39, 58, and 78. Applicants believe that claims 22, 39, 58, and 78 are allowable over the cited combinations of Berken and

Richter with Cripps, Perkins, Callon, Reece, Lewen, Lewen and McKee, and Focsaneanu, in that Cripps, Perkins, Callon, Reece, Lewen, Lewen and McKee, and Focsaneanu fail to overcome the shortcoming of Berken and Richter, as set forth above. Because claims 23, 26, 27, 31, 32, 40, 43, 44, 48, 49, 59, 60, 62, 67, 68, 75, 77-79, 80, 81, 87 and 88 depend from allowable claims 22, 39, 58, and 78, Applicants respectfully submit that claims 23, 26, 27, 31, 32, 40, 43, 44, 48, 49, 59, 60, 62, 67, 68, 75, 77-79, 80, 81, 87 and 88 are also allowable, for at least the same reasons. Therefore, Applicants respectfully request that the rejections of claims 23, 26, 27, 31, 32, 40, 43, 44, 48, 49, 59, 60, 62, 67, 68, 75, 77-79, 80, 81, 87 and 88 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### **"Original" Rejection**

The instant Office action sets forth on pages 20-34 under a section titled "Original Rejection", rejections of claims 22-72 under 35 U.S.C. §103(a) over Sainton (US RE38787) in view of Richter, and further in view of Cripps, Honing, Perkins, Weaver, Callon, and Reece. These rejections, under the label of "Original Rejection" appears not to be a restatement of prior rejections, but instead, appear to be a modified copy of the rejection of claims 22-72 under 35 U.S.C. §103(a) over Sainton (US RE38787) in view of Drakopoulos, and further in view of Cripps, Honing, Perkins, Doviak, Weaver, Callon, and Reece, set forth in the Office action mailed September 7, 2006, in which the Examiner has substituted Richter for Drakopoulos. Applicants respectfully traverse the se rejections.

Applicants respectfully request that the examiner explain the intended meaning of the section title "Original Rejection", in that the rejections of claims 22-72 under 35 U.S.C. §103(a) over Sainton and Richter with Cripps, Honing, Perkins, Weaver, Callon, and Reece that appear on page 20 of the instant Office action, have not appeared in a prior Office action, but are labeled by the title to distinguish them from the rejections under Berken and Richter.

Applicants respectfully submit that Applicants have addressed the alleged teachings of Sainton set forth in the Office action mailed May 2, 2006, in the response filed September 7, 2006. Applicants respectfully submit that the Office action has fails to show where Richter remedies the shortcomings of Sainton set forth in Applicants' prior responses. For reasons of brevity and clarity, Applicants hereby incorporate herein Applicants' prior responses of record in the Application and will not repeat those arguments here. Applicants believe that the claims of the Application define allowable subject matter.

The Applicants appreciate recognition by the Office that Sainton "...does not explicitly disclose destination information." (page 22, line 13) However, in an attempt to overcome this shortcoming of Sainton, the Office turns to Richter and states, in part, that "...Richter teaches wherein digital voice packets comprise destination information used for routing..." (page 22, line 16) The Office continues by asserting that "...therefore, it would have been obvious to one having ordinary skill in the at the time the invention was made to provide destination, as taught by in the system of Sainton [sic], so that it would provide capability to the caller and callee to hear each other; see Richter col. 7, line 10-19, and it would also identify and locate the recipient of the voice data packet, and it would ensure the network to route the voice packet to destination end user." (Office action at page 22, line 21 to page 23, line 3)

Applicants respectfully submit that the Office has identified the alleged motivations for modifying the system of Sainton using Richter as, "...so that it [Sainton's omni-modal wireless system] would provide capability to the caller and callee to hear each other...", "...it would also identify and locate the recipient of the voice data packet...", and "...it would ensure the network to route the voice packet to destination end user...." Applicants respectfully submit that the alleged motivations for making the combination are not valid motivations, in that the system of Sainton already functions to "...provide capability to the caller and callee to hear each other...", "... identify and locate the recipient of the voice data packet...", and "...ensure the network to route the

voice packet to destination end user....” Applicants respectfully submit that Sainton discloses “...wireless communication devices and systems adapted to enable voice and/or data transmission to occur using a variety of different radio frequencies, transmission protocols and radio infrastructures....” (Background) Applicants assume that, based upon assertions by the Office that Sainton teaches “...at least one portable terminal having a wireless transceiver adapted for communication using a packet protocol;...”, “...the at least one portable terminal adapted for converting sound into digital voice packets for transmission via the wireless transceiver, and for receiving digital voice packets via the wireless transceiver, the contents of the digital voice packet for conversion into sound;...”, “...the at least one portable terminal adapted for capturing digital data into data packets for transmission via the wireless transceiver, and for receiving data packets via the wireless transceiver, the contents of the data packets used for reproducing digital data;...”, and “...at least one access device having a wireless transceiver for exchanging one or both of digital voice packets and digital data packets with the at least one portable terminal, the at least one access device comprising a network interface for exchanging information via a wired network...”, that Sainton functions to, at least, “...provide capability to the caller and callee to hear each other...”, “... identify and locate the recipient of the voice data packet...”, and “...ensure the network to route the voice packet to destination end user....” Applicants respectfully submit that if Sainton did not function to “...provide capability to the caller and callee to hear each other...”, “... identify and locate the recipient of the voice data packet...”, and “...ensure the network to route the voice packet to destination end user...”, then the system of Sainton would also not teach the features of Applicants claims 22, 39, 58, and 78. Therefore, Applicants respectfully submit that the alleged motivations to “...provide capability to the caller and callee to hear each other...”, “... identify and locate the recipient of the voice data packet...”, and “...ensure the network to route the voice packet to destination end user...” are not valid or proper motivations for one of ordinary skill in the art to seek to modify Sainton using the teachings of Richter. Based at least upon the above, Applicants respectfully submit that the Office has failed to identify “...some suggestion or motivation, either in the references themselves or in the



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knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings...", as required by M.P.E.P. §2142, and that the Office has failed to establish a *prima facie* case of obviousness.

In light of the above, Applicants respectfully submit that the Richter reference was chosen without a valid or proper motivation, and instead, was chosen because it allegedly discloses the one feature of Applicants' claims 22, 39, 58, and 78, namely "destination information", admitted by the Office to be missing from Sainton. (Office action at page 22, line 13)

Applicants respectfully submit that M.P.E.P. 2141 (II)(B) states, in part, "references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination." This is also supported in case law, "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Weslau*, 353 F.2d 238, 241 (United States Court of Customs and Patent Appeals, 1965) (emphasis added).

Therefore, Applicants respectfully submit that Applicants' claims 22, 39, 58, and 78 are allowable over the proposed combination of Sainton and Richter, for at least the reasons set forth above. Applicants respectfully submit that claims 23-38, 40-57, 59-72 and 74-88 depend either directly or indirectly from independent claims 22, 39, 58 and 73, respectively. Because claims 23-38, 40-57, 59-72 and 74-88 depend from independent claims 22, 39, 58 and 73, Applicants respectfully submit that claims 23-38, 40-57, 59-72 and 74-88 are also allowable, for at least the same reasons. Therefore, Applicants respectfully request that the rejections of claims 22, 39, 58, and 78, and the claims that depend therefrom under 35 U.S.C. §103(a) be reconsidered and withdrawn.

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## Conclusion

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of pending claims 22-88 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000. If the Examiner maintains his rejections, the Applicants hereby respectfully request an interview with the Examiner.

The Commissioner is hereby authorized to charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Dated: November 15, 2007  
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